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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/072,042

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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3781

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/072,042

Applicant(s)

NYKOLUK ET AL.

Examiner

Tri M. Mai

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-87 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 47-87 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. Claims 47-50, 52-64, 66-76, and 78-85 are under 35 U.S.C. 103(a) as being unpatentable over Lu '344 in view of Miyoshi (5908093). Lu teaches a towing member having an arm having distal end and proximal end with an axial length, a towing handle 20, a locking mechanism located proximate the handle movable between a locked position and an unlocked position comprising a movable locking element defining a slot at 325 and a locking protrusion 50 extending through the slot, and a release mechanism as claimed.

With respect to the distal end of the arm being otherwise unable to move relative to the proximal end. The examiner submits that one can have the towing handle pivotable about one axis about the handle as claimed. There is no structural differences between the claimed device and the device in Lu.

With respect to the non extendable portion, it would have been obvious to one of ordinary skill in the art to provide an extendable portion as taught by Miyoshi (Fig. 5, portion 55A) to provide a connection to the luggage.

Regarding claim 21 it is noted that there are two single poles telescoping member as claimed.

Regarding claim 57, note that there is a face facing outward in Lu (adjacent the distal peripheral edge of portion 35).

Regarding claim 57 and 71, note the channels 421 between the locking protrusions.

Regarding claim 63, note that the tube is curved forward as claimed.

Regarding claim 71, note the channels 712 in Lu.

Regarding claim 49, it would have been obvious to one of ordinary skill in the art to provide curved arm portions to enable one to tow the luggage easily.

2. Claim 47-50, 52-64, 66-76, and 78-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Lu'344 rejection, as set forth above, and further in view of either Dean (3355075) or Murphy (4368835). To the degree it is argued that the handle in Lu does not teach the outwardly extending handle, either Dean or Lu teaches that it is known in the art to provide back support structures being curved to accommodate the back. It would have been obvious to one of ordinary skill in the art to provide outwardly curved handle as taught by either Dean or Lu to enable one to support the handle on the back when wearing.
3. Claims 51, 65, 77, 86, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu in view of either Chen '951 or Chen (6434790). Lu meets all claimed limitations except for the single pole handle. Either Chen '951 or Chen '790 teaches that it is known in the art to provide a single pole handle. It would have been obvious to one of ordinary skill in the art to provide single pole handle as taught by either Chen '951 or Chen '790 to save material or manufacture the device easily.
4. Claims 47-60, and 74-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (6591951) in view of Miyoshi, and further in view of either Dean or Lu '344. Chen teaches a towing member having an arm having distal end and proximal end with an axial length, a towing handle 20, a locking mechanism 40 located proximate the handle movable between a locked position and an unlocked position comprising a movable locking element 44 as claimed. Chen meets all claimed limitations except for the non extendable portion. Miyoshi teaches that it is known in the art to provide a non extendable portion. It would have been obvious to one of ordinary skill in the art to provide a non extendable portion as taught by Miyoshi to provide a connection to the luggage.

Regarding claim 58, note locking protrusions 441 forming a channel there between.

With respect to the arm being curved, Dean or Lu teaches that it is known in the art to provide curved Dean or Lu teaches that it is known in the art to provide back support structures being curved for supporting on the back. It would have been obvious to one of ordinary skill in the art to provide outwardly curved handle as taught by either Dean or Lu to enable one to support the handle on the back when wearing.

Response to Arguments

5. Applicant's arguments have been fully considered but they are not persuasive. Applicant affidavits are insufficient to overcome the Lu reference as set forth in the previous Office Action. Inter alias, the affidavit fails to show the locking mechanism as claimed. Applicant's attention is directed to the following sections in the MPEP.

715.07 [R-3] Facts and Documentary Evidence:

.....

As discussed above, 37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show

(A) **actual** reduction to practice of the invention prior to the effective date of the reference; or

(B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or

(C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS THE INVENTOR FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. *Automatic Weighing Mach. Co. v. Pneumatic Scale Corp.*, 166 F.2d 288, 1909 C.D. 498, 139 O.G. 991 (1st Cir. 1909).

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

The affidavit is required the showing of facts of actual reduction to practice of the invention. In this case, it is noted none of the affidavit shows the locking mechanism that applicant is claiming in this instant application. With respect to the Lu and Miyoshi combination, as set forth above, the examiner noted that claimed meets all claimed limitations except for the nonextendable portion that is attached to the luggage. Miyoshi clearly shows this feature in Fig. 5, portion 55A, to provide a connection to the luggage. Thus, it would have been obvious to one of ordinary skill in the art to provide a nonextendable portion by Miyoshi to provide the connection to the luggage.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, applicant's assertion that Miyoshi do not teach the towing handle pivot about the center axis is while completely ignore the teachings from the primary reference which clearly show the handle with the locking mechanism that operates as set forth in the claim. Applicant also uses the same misleading arguments with respect other combination, applicant fails to point out exactly what is missing from one reference, while ignoring the teachings from other references.

With respect to the arm being curved, the examiner submits that the arms in Lu'344 is curved as noted by the drawings.

The examiner also submits the following principle of law under KSR Int'l Co. v. Teleflex Inc. In KSR, the Supreme Court cautioned the granting of patents based on the combination of elements found in the prior art. The Supreme Court wrote that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

In this case, numerous arts in this case show the rotatable towing handle as noted by Lu '344, Chen '951, and Chen '790. It is also submitted that Dean and Miyoshi and Lu '344 teaches the curving of the handle to accommodate the back. The examiner submits that all combinations as set forth above are clear cases of prima facie. The examiner submits that the motivation is to have the structure to conform to the back of the user as noted by Lu'344 and Dean. Furthermore, given the numerous references presented in this case, the examiner submits that the device as claimed are one of predictable variation and § 103 likely bars its patentability.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571)272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tri M. Mai 
Primary Examiner
Art Unit 3727